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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	000790/0007	9970
26610 7590 05/18/2007 STROOCK & STROOCK & LAVAN LLP 180 MAIDEN LANE NEW YORK, NY 10038			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,36-51 and 63-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,36-51 and 63-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/27/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 1, 3, 5-35, 52-62, and 75-94 are canceled. All pending claims (2, 4, 36-51, and 63-74) were examined in this final office action. New grounds of rejection necessitated by IDS apply.

Response to Arguments

Applicant's arguments filed 05 March 2007 have been fully considered but they are not persuasive. Toohey teaches a system and method of synchronizing/mediating an electronic commerce shopper's purchase with a payment process as managed by an electronic commerce mall, facilitated by the use of a virtual ledger associated with a virtual store shopping basket, and further teaches managing a plurality of virtual ledgers associated with individual transactions. Takayama provides pertinent teaches related to wireless commerce and transaction processing.

The Examiner is suggesting the Applicant consider a telephone interview for further discussion pertaining to subject matter. The purpose of the interview would be to discuss forward moving strategy pertaining to either allowance or appeal. The Examiner is willing to work with the Applicant to help resolve deadlock on this case to identify potential allowable subject matter, if any, that may be incorporated into the independent claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 1. Claims 36, 43, 51, 63, 66, and 74 provisionally rejected on the ground of nonstatutory double patenting over claims 54, 71, and 84 of copending Application No. 09/630,557. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: mediating server that synchronizes billing with payment by user via a paying terminal (i.e. device such as a PDA).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the

other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- 2. Claims 36, 43, 51, 63, 66, and 74 provisionally rejected on the ground of nonstatutory double patenting over claims 1, 3, 66, and 77 of copending Application No. 09/786,208. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: first and second terminals by design/definition with transaction apparatus mediating billing with payment by user via a paying terminal (i.e. device such as a PDA).

Transaction IDs or equivalent are inherent. System functionality depends of being able to uniquely distinguish between transactions.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 2, 4, 36-41, 43-48, 50-51, 63-68, 70, 71, and 73- 75 are rejected under 35 USC 103(a) as being unpatentable over Toohey (US 6,405,176) in view of Takayama (US 6,332,133).**

Toohey teaches a system and method of synchronizing an electronic commerce shopper's purchase with a payment process as managed by an electronic commerce mall, facilitated by the user of a virtual ledger associated with a virtual store shopping basket, and further teaches managing a plurality of virtual ledgers (see at least abstract ; col. 1-2). Toohey further teaches:

- *a communicating section connected to the communicating network;*

Inherent in Toohey are the structures necessary for a communicating section connected to the communicating network. For example, Toohey discloses a electronic commerce shoppers accessing virtual stores managed by a computer-based data processing system (see at least col. 2, lines 1-67). Please note: Toohey references to online shopping sites and making improvements to online shopping sites pertains to online

shopping sites connected to a communicating network (see at least col. 1, lines 5-25).

- and a processing unit for communicating with said paying terminal and with said virtual register through said communicating section, said processing unit setting up link information including transaction ID information in association with said virtual register and transmitting said link information which is indicatable in the information indicating unit of the paying terminal upon receipt of the information regarding the transaction transmitted by the paying terminal, said processing unit establishing a synchronization of communication between said paying terminal and said virtual register one-to-one upon receipt of both the same transaction ID information and a signal in response to the link information from said paying terminal. processing unit (i.e. computer-based system that manages electronic commerce transactions in a virtual mall) (see at least Fig. 1 (42); col. 2, lines 52-55); paying terminal (i.e. electronic commerce shopper's electronic device in communication with the virtual mall computer) (see at least Fig. 1 (46); col. 3, lines 30-35); assigning to each electronic commerce shopper a virtual ledger for each virtual store (i.e. one-to-one relationship) (see at least Fig. 1 (50); col. 2, lines 42-45); processing unit synchronizes payment into single payment transaction (see at least col. 2, lines 35-41; col. 3, lines 1-10);

Art Unit: 3625

- Cashier server: virtual mall computer performs function of cashier server.
Please see above citations.
- Databases: collects/records/stores all purchase data/transaction data
(please note: what data is stored has no consequence on the system structure; storing/recording requires memory) (see at least col. 2, lines 42-51; col. 3, lines 36-46).
- Communication addresses; Inherent in Toohey are the structures necessary to permit the communication of a network address to the shopper's terminal. For example, Toohey discloses the shopper accessing the virtual shopping cart, which in turn communicates with the virtual ledger, and further disclose that by association of the mall with the virtual shopping cart, the mall can obtain a reference to each virtual ledger containing store items (i.e. reference is an identifier) (see at least col. 3, lines 36-47).

Toohey teaches all the above as noted under the 103(a) rejection and further teaches the mall server synchronizing a) a payment transaction with the shopper associated with a virtual ledger, and b) synchronizing a payment transaction associated with plurality of virtual ledgers, but does not specifically disclose use of a transaction ID. Takayama teaches an electronic commerce system and method and serves as a teaching reference pertaining to the use of transaction identification in the form of transaction numbers uniquely associated with a consumer purchase and payment (see at least Fig. 26 (2616); col.71, lines 32-

40). Therefore it would have been obvious to one of ordinary skill in the arts at time of the invention to modify the system and method of Toohey to issue a transaction number unique to a customer purchase and payment as taught by Takayama, in order to associate a given transaction from among a plurality of transactions for a particular purchase.

Toohey teaches all the above as noted under the 103(a) rejection and teaches online communication between an electronic commerce shopper and the electronic mall computer, but leaves one of ordinary skill in the art to ascertain means of online communication with the electronic mall computer. Takayama teaches all the above as noted under the 103(a) rejection and serves as a teaching reference pertaining to the use of wireless devices in electronic commerce shopping. Takayama teaches portable wireless telephones as being more convenient (over wire lines) as a remote device in communication with the digital network, and further teaches portable wireless telephones as a paying terminal with voice input and receiving address information from the online service (please note: digital network uses telephone lines) (see at least Fig. 1 (100, 108); col. 44, lines 7-8). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Toohey to support portable wireless telephones as paying terminals with voice input capable of receiving network address information as taught by Takayama, in order to provide more convenience to the consumer, and thereby increase sales for the service.

- 4. Claims 42, 49, and 69 are rejected under 35 USC 103(a) as being unpatentable over Toohey (US 6,405,176) and Takayama (US 6,332,133), as applied to claims 36, 43, and 63, and further in view of Official Notice (regarding old and well-known in the arts).**

Toohey and Takayama teach all the above as noted under the 103(a) rejection and teach a) transaction identifiers to uniquely identify a transaction associated with purchase, and b) other information included with the transaction data, but do not disclose information regarding the transaction included a number listed in at least one of a mail order advertisement and a catalog distributed to a user in advance. The Examiner takes the position that it is old and well-known in the arts for merchants to provide a consumer with a catalog reference number (i.e. printed on the catalog) or to identify to a consumer a reference number associated with a particular promotion or advertisement for the purpose of tracking merchant sales activities and/or to offer purchasing incentives associated with the reference number as a consequence of a purchasing transaction. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Toohey and Takayama to include a number listed as taught by Official Notice, in order to provide a merchant with tracking information associated with marketing activities and/or purchasing incentives.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 05 March 2007 prompted the new ground(s) of rejection of Double Patenting presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

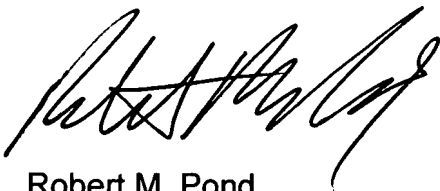
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax

Art Unit: 3625

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is written over a horizontal line.

Robert M. Pond
Primary Examiner
May 13, 2007